

REMARKS

In the Office Action dated January 7, 2009, claims 1-15 were presented for examination. Claims 1-15 were rejected under 35 U.S.C. §112, first and second paragraphs. Claims 1-15 were rejected under 35 U.S.C. §103(a) as being unpatentable over *Krause*, U.S. Patent Application Publication No.2005/0180568, in view of *Karim*, U.S. Patent Application Publication No.2003/0217108, and in further view of *Lacy et al.* (hereinafter referred to as *Lacy*), U.S. Patent Application Publication No.2004/0205485.

The following remarks are provided in support of the pending claims and responsive to the Office Action of January 7, 2009 for the pending application.

I. Rejection of Claims 1-15 Under 35 U.S.C. §112, first paragraph

In the Office Action dated January 7, 2009, the Examiner rejected claims 1-15 under 35 U.S.C. §112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to make and/or use the invention. There are two separate and distinct issues raised by the Examiner with respect to this rejection, including the limitation pertaining to temporarily coding a broadcasting payload to a set of symbols, and transmission of the payload.

With respect to the employment of the “symbols,” the Examiner points out that the use of symbols is not properly defined in the specification. To overcome this portion of the rejection, Applicant has removed the controversial language pertaining to “a set of symbols.” Accordingly, based upon removal of the language in question from the claims, Applicant respectfully requests that the Examiner remove the rejection under 35 U.S.C. §112, first paragraph and grant an allowance of the pending claims.

Furthermore, the Examiner points out that the specification does not clearly disclose “how the packet can be sent without a payload and vice versa.” Applicant respectfully disagrees with the Examiner’s position. Applicant claims creation and storage of a replacement payload in a header of a broadcast packet, followed by transmission of the packet with the replacement payload. Once the transmission packet is at the receiving end, the replacement payload is then

converted to the full broadcasting packet. The purpose of the replacement and transmission of the full payload is to allow a “user to more quickly and more efficiently transmit broadcasting packets without encountering the bottlenecks in the routing of such transmissions that currently exist.” U.S. Patent Publication No. 2005/0125,554, Col. 3 lines 6-9.

It is to be remembered, when rejecting a claim under the enablement requirement of 35 U.S.C. §112, the U.S. Patent and Trademark Office bears the initial burden of setting forth a reasonable explanation as to why it believes the scope of protection provided by the claimed subject matter is not adequately enabled by the description of the invention provided in the specification of the application. This includes providing sufficient reasons for doubting any assertions in the specification as to the scope of enablement. If this burden is met, the burden then shifts to the appellants to provide suitable proof that the specification is enabling.¹ In this respect, the Examiner’s further argument that the original specification “does not clearly disclose how a packet can be sent without a payload and vice-versa without a header” is based upon an unfounded premise. The original specification clearly states the original payload is temporarily replaced and that the replacement payload is then placed in the packet header and transmitted. Upon completion of the transmission, the original payload and replacement payload are switched. See paragraph 0022. This is not lacking clarity of a form of minimal direction, as this is a clear working example that would enable one of ordinary skill in the art to make and use the packet replacement and transmission in the manner claimed by Applicant. The packet is not transmitted without a header - the packet is transmitted with a replacement header that is “lighter” to enable a more efficient transmission.

Based upon the above comments, it is respectfully submitted that the rejection under 35 U.S.C. §112, paragraph one, on the grounds of “lack of enablement” fails to meet the above requirements and is without merit. It should be withdrawn and a notice of allowance immediately issued.

¹See *In re Wright*, 999 F.2d 1557, 1561-62, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993), and *In re Marzocchi*, 439 F.2d 220, 223-24, 169 USPQ 367, 369-70 (CCPA 1971).

II. Rejection of Claims 1-15 Under 35 U.S.C. §112, second paragraph

In the Office Action dated January 7, 2009, the Examiner rejected claims 1-15 under 35 U.S.C. §112, second paragraph as failing to set forth the subject matter regarded by Applicant as his invention. More specifically, the Examiner raises concern regarding the language comprising “a set of symbols.” To overcome the above rejection, Applicant has removed the controversial language pertaining to “a set of symbols.” Accordingly, based upon removal of the language in question from the claims, Applicant respectfully requests that the Examiner remove the rejection under 35 U.S.C. §112, second paragraph and grant an allowance of the pending claims.

III. Rejection of Claims 1-15 Under 35 U.S.C. §103(a)

In the Office Action dated January 7, 2009, the Examiner rejected claims 1-15 under 35 U.S.C. §103(a) as being unpatentable over *Krause*, U.S. Patent Application Publication No. 2005/0180568, in view of *Karim*, U.S. Patent Application Publication No. 2003/0217108, and in further view of *Lacy et al.* (hereinafter referred to as *Lacy*), U.S. Patent Application Publication No. 2004/0205485.

Applicant’s remarks pertaining to the prior art as applied to the pending claims as presented in the Appeal Brief and prior communications, are hereby incorporated by reference.

As noted by the Examiner in the outstanding Office Action, “*Krause* fails to disclose that an electronic distribution system for routing broadcasting packets from a sending server to a receiving server.”² More specifically, the system of *Krause* is not an electronic document distribution system for routing broadcasting packets from a sending server to a receiving server. *Krause* does not teach a replacement payload for the broadcast payload, adding the replacement payload to a header of the broadcasting packet, and converting the replacement payload of the broadcasting payload from its format to form a full broadcasting packet in the receiving server, as claimed by the Applicant.

²See Office Action, page 9, last paragraph.

The teachings in *Karim* also fail to make up for the deficiencies in *Krause*. *Karim* teaches a method to allow electronic mail users to engage in an interactive dialog session without needing any other information required by proprietary interactive communication mechanisms not generally available to users.

The teachings in *Lacy et al.* fail to make up for the deficiencies in *Krause*. More specifically, *Lacy et al.* teaches an apparatus for compressing media content. *Lacy et al.* teaches a watermarking technique for inserting a data stream not associated with the media content into a compressed media content bit stream. However, the watermarking technique of *Lacy et al.* does not teach the replacement payload of Applicant. More specifically, Applicant claims a replacement payload being added to the header of a broadcasting packet for transmission to the receiving server via the broadcasting router, wherein the replacement payload includes data that is substantially smaller than the content of the original payload. Following receipt in the receiving server, the replacement payload is converted to the original payload. Accordingly, it is clear that Applicant claims a payload replacement mechanism that is not taught in *Lacy et al.*

Independent claims 1, 6, and 11 each specifically claim replacement of the original payload from the packet. More specifically, the broadcast payload is stripped temporarily from the broadcast packet, and replaced with a smaller replacement payload. See paragraph 0022 of Applicant's published patent application. The Examiner relies on *Krause* to teach "means for temporarily replacing the stripped broadcasting payload." However, *Krause* cannot replace that which was not stripped. More specifically, the only replacement that takes place in *Krause* is replacement of the headers. Applicant claims replacement of the payload - not replacement of the header. Furthermore, *Lacy et al.* also does not teach this replacement mechanism, as *Lacy et al.* pertains to watermarking.

"To establish a rejection under 35 U.S.C. §103(a), all the claim limitations must be taught or suggested on the prior art."³ If the prior art references do not teach or suggest every claim limitation of the Applicant's invention, then they do not meet every requirement under 35 U.S.C.

³MPEP §2143.03 (Citing *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974)).

§ 103(a) and are not sufficient to uphold a rejection under 35 U.S.C. § 103(a). As noted above, there is no teaching or suggestion in the prior art references of *Krause*, *Lacy et al.* or *Karin* to employ the technique of the replacement payload in the manner claimed by Applicant. It is Applicant's position that the claims, in their prior form and as amended, are patentable over the prior art based upon the current state of the law as applied to the legal definition of obviousness. The requirements for upholding a rejection under 35 U.S.C. § 103(a) are clearly outlined in *Graham v. John Deere*⁴ and maintained as a standard in the law in the Supreme Court decision of *KSR International Co. V. Teleflex, Inc.*⁵, hereinafter referred to as *KSR*. Under *Graham v. John Deere*, the first and second steps required for evaluating a prior art reference under 35 U.S.C. § 103(a) are to first determine the scope and contents of the prior art and then ascertain the differences between the prior art and the claims in issue.⁶ As the record has shown, *Krause*, *Lacy et al.*, and *Karmin* do not teach or suggest use of a replacement payload to reduce the size of the packet transmission, and therefore improve packet transmission efficiency as a whole.

Furthermore, based on the record before us, it appears that the Examiner is employing biased hindsight reconstruction to parse the claims elements. "A factfinder should be aware, of course, of the distortion cause by hindsight bias and must be cautious of arguments reliant upon ex post reasoning."⁷ There is always a temptation to read into the prior art the teaching of the invention. This is probably truer in some areas of technology more than others. However, the regardless of the ordinary skill in the art, it is clear that the prior art as applied by the Examiner

⁴*Graham v. John Deere*, 383 U.S. 1, 148 USPQ 459 (1966) (holding that under §103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background, the obviousness or nonobviousness of the subject matter is determined).

⁵*KSR International Co. V. Teleflex Inc. et al.*, 550 U.S. ____, 127 S.Ct. 1727 (2007), citing *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006).

⁶*Graham v. John Deere*, 383 U.S. 1, 148 USPQ 459 (1966) (holding that under §103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background, the obviousness or nonobviousness of the subject matter is determined).

⁷*KSR International Co. V. Teleflex Inc. et al.*, 550 U.S. ____, 127 S.Ct. 1727 (2007), citing *Graham v. John Deere*, 383 U.S. 1, 148 USPQ 459 (1966).

does not extend to creation and transmission of a replacement payload, followed by a rejoin of the original payload once the transmission is completed. Accordingly, it is submitted that the suggestion for the combination as set forth by the Examiner is biased and improper.

Furthermore, even if the elements of the prior art references were combined in the manner suggested by the Examiner, the combination still fails to teach all of the claimed limitations. The combination of prior art references still fails to teach the creation and employment of the replacement payload for transmission across a communication network. Based upon the current standard of the law of obviousness under 35 U.S.C. §103(a), it is Applicant's position that the rejection set forth by the Examiner is improper and should be removed. Accordingly, Applicant respectfully requests that the Examiner remove the rejections herein and grant an allowance of the pending claims.

IV. Conclusion

In view of the forgoing remarks to the claims, it is submitted that all of the claims remaining in the application are now in condition for allowance and such action is respectfully requested. Applicant is not conceding in this application that those claims in their prior forms are not patentable over the art cited by the Examiner, as the present claims are only for facilitating expeditious prosecution of the application. Applicant respectfully reserves the right to pursue these and other claims in one or more continuation and/or divisional patent applications. Should any questions arise in connection with this application or should the Examiner believe that a telephone conference with the undersigned would be helpful in resolving any remaining issues pertaining to this application, the undersigned respectfully requests that she be contacted at the number indicated below.

Applicant believes that a full and complete reply has been made to the outstanding Office Action and, as such, the present application is in condition for allowance. Accordingly, Applicant requests that the Examiner indicate allowability of claims 1-15, and that the application pass to issue. If the Examiner believes, for any reason, that personal communication

will expedite prosecution of the application, the Examiner is hereby invited to telephone the undersigned at the number provided.

For the reasons outlined above, withdrawal of the rejection of record and an allowance of this application are respectfully requested.

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